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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/501,894      | 08/23/2004  | Ernst Brunbauer      | 55922/3             | 9010             |

71130 7590 01/25/2008  
SEYFARTH SHAW LLP  
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BOSTON, MA 02210-2028

EXAMINER

HALPERN, MARK

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1791

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

01/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/501,894 | <b>Applicant(s)</b><br>BRUNBAUER ET AL. |  |
|                              | <b>Examiner</b><br>Mark Halpern      | <b>Art Unit</b><br>1791                 |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 12/6/07 and 12/10/07 have been entered. Claims 1, 10 are amended, claims 11-12 are cancelled, and new claims 13-14 are offered for consideration.

### ***Specification***

2) The content of the Specification is not complete; the Specification does not include a BRIEF DESCRIPTION OF DRAWINGS.

Inserting the BRIEF DESCRIPTION OF THE DRAWINGS and DETAILED DESCRIPTION OF THE INVENTION into Page 2, line 13, as suggested in the Amendment of 12/10/2007, is not accepted, since DETAILED DESCRIPTION exists and starts on Page 3, line 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3) Claims 1-5, 9 are rejected under 35 U.S.C. 103(a) as obvious over Hammersmith (6,645,605)

Claims 1-2, 4, 9: Hammersmith discloses (as shown in Figure 1) a process of making a cigarette paper that includes the application of a thermoplastic polymer aqueous suspension from nozzles 3 onto the paper after the paper leaves a nip formed by printing cylinder 1 and an impression roller 2. The application of the polymer onto the paper occurs while the paper travels through a series of dryer rolls 4 after which the paper gets windup onto roll 5 (col. 7, line 61 to col. 8, line 14, and Figures 1-2). The thermoplastic polymer is a water soluble polymer (col. 4, lines 27-44). An acetates polymeric compound is disclosed (col. 2, lines 29-56). The printing solution applied paper is raised above 50 °C (Example 3, col. 11). Hammersmith does not disclose the paper undergoing polymer application moisture content to be in the range between about 2% and about 60%, however, it would have been obvious, to one skilled in the art at the time the invention was made, that the paper moisture is in the claimed range, because the paper has been formed and after the forming stage it is the normal moisture range of a formed web.

Claim 3: it would have been obvious to have temperature higher than the value of polymers precipitation from water in order to speed up the process of drying of paper prior to rollup.

Claim 5: printing solution viscosity is disclosed in Table I, column 9-10.

4) Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hammersmith in view of Ishino (5,849,153). Hammersmith is applied as above for claim 1, Hammersmith does not disclose the paper basis weight. Ishino discloses the formation of a paper sheet and the printing of a coating layer made of water soluble polymer solution (Abstract and cols. 3-4). The Ishino paper basis weight is 15-80 g/m<sup>2</sup> (col. 7, lines 50-55). It would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Hammersmith and Ishino, because such a combination would provide the Hammersmith process to a variety of cigarette paper applications.

5) Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammersmith in view of Hamajima (5,496,626).

Claim 7: Hammersmith is applied as above for claim 1, Hammersmith fails to disclose the paper absorption rate. Hamajima discloses a paper having an absorption rate of less than 30 mm after 10 minutes (col. 7, lines 43-55). Hammersmith and Hamajima disclose the elements of the invention. One of ordinary skill in the art could have combined the elements by known methods since the combination of Hammersmith and Hamajima is a combination of known methods, and each element combined would have performed the same function as it did separately, and thus one of ordinary skill in the art would have recognized that the results of the combination were **predictable**.

Claim 8: Hamajima discloses a paper having an absorption rate of less than 30 mm after 10 minutes (Hamajima, col. 7, lines 43-55).

6) Claims 9-10, 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammersmith in view of Hamajima and further in view of Kraker (6,779,530).

Claim 9: Hammersmith in view of Hamajima is applied as above for claim 8, Hammersmith in view of Hamajima fails to disclose the roller serving as a backing support. Roller backing is disclosed by Kraker in Figure 3. Hammersmith, Hamajima and Kraker disclose the elements of the invention. One of ordinary skill in the art could have combined the elements by known methods since the combination of Hammersmith, Hamajima and Kraker is a combination of known methods, and each element combined would have performed the same function as it did separately, and thus one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 10: entire width of paper is coated. The polymer contains fire promoting means (Hammersmith, Abstract).

Claims 13-14: reduced ignition proclivity is disclosed (Kraker, Title).

### ***Response to Amendment***

7) Claims 1-4, 6 rejection under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishino, is withdrawn in view of amended claims.

8) Claim 5 rejection under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Kraker, is withdrawn in view of amended claims.

- 9) Claims 7-8 rejection under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Hamajima, is withdrawn in view of amended claims.
- 10) Claims 9-11 rejection under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Hamajima and further in view of Kraker, is withdrawn in view of amended claims.
- 11) Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

- 12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone no. is 571-272-1190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK HALPERN  
PRIMARY EXAMINER